

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

Claims 1-22 were pending in this application. In this Amendment, Applicants have cancelled claims 10 and 11 and have amended claims 1, 2, 6, 14, 18, 20, and 22. Accordingly, claims 1-9 and 12-22 will be pending upon entry of this Amendment.

In the Office Action mailed June 7, 2005, the Examiner objected to informalities in claim 15. The Examiner rejected claims 1-22 under 35 U.S.C. § 112, ¶¶ 1-2, for failing to comply with the written description and enablement requirements and for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. The Examiner also rejected claims 1-22 under 35 U.S.C. § 101 as directed to non-statutory subject matter. The Examiner also rejected claims 1-7 and 10-12 under 35 U.S.C. § 102 as anticipated by U.S. Published Patent Application 2002/0059093 to Barton et al. ("Barton"), and rejected claims 8, 9, and 13-22 under 35 U.S.C. § 103(a) as unpatentable over Barton. The Examiner also issued a Requirement for Information under 37 C.F.R. § 1.105 requesting certain information from the Applicants and assignee of the present invention.

In response to the Office Action, Applicants have amended claims 1, 2, 6, 14, 18, 20, and 22. To the extent the rejections might still be applied to claims presently pending in this application, Applicants respectfully traverse the rejections as set forth below under corresponding subheadings.

Claim Objections

The Examiner objected to claim 15 because of an extra occurrence of the phrase “of the” in line 1. Applicants believe, however, that this informality was corrected in the Preliminary Amendment filed March 8, 2005. As such, Applicants respectfully submit that the informality is no longer present in pending claim 15 and request withdrawal of the objection.

Applicants have also amended claim 22 to correct matters of form.

35 U.S.C. § 112, ¶¶ 1-2

In rejecting independent claims 1, 14, and 20 under § 112, the Examiner cited four primary bases: (1) the scope of the steps and the extent to which a computer is involved are unclear; (2) the claims do not accomplish what the preambles set out to complete; (3) the association between a characteristic (*e.g.*, actor), process, and element is unclear; and (4) the claimed invention does not produce a concrete result. In response, Applicants have amended claims 1, 14, and 20 to clarify the scope of the method steps, to better correlate the preambles to the bodies of the claims, to clarify the association between characteristic, process, and element, and to clarify the concrete results.

Regarding the scope of the steps, the Examiner stated that it is unclear who or what performs the recited “associating” and “defining” steps as between a computer and a human user. In response, Applicants have amended claims 1, 14, and 20 to eliminate references to a subject that is performing the steps (such as a computer). In this manner, the invention is defined by the steps of the method, rather than who or what is performing the steps. Indeed, the steps could be performed, for example, by a computer, a human user, or a combination thereof. What is

important is the steps themselves, and the overall method that is recited in the claims. Support for the recited steps themselves can be found throughout the specification and specifically, for example, with reference to Figure 1E and paragraph [0084]. Applicants therefore respectfully submit that the scope of the steps is adequately supported by the written description and is not vague or indefinite.

Regarding the preambles, Applicants have amended claims 1, 14, and 20 to recite preambles corresponding to the bodies of the claims. The preamble of amended claim 1 recites a method for illustrating an operation of an organization, corresponding to a method that results in the display of an association between a characteristic, process, and element. The preamble of amended claim 14 recites a method for illustrating a scope of an outsourcing, corresponding to a method that results in the display of the scope, which graphically presents the association between an associated actor, process, and element. Likewise, the preamble of amended claim 20 recites a method for illustrating interactions between an organization and an outsourcer participating in an outsourcing, which corresponds to a method resulting in the display of interaction models for interactions between the organization and the outsourcer. Thus, Applicants respectfully submit that the bodies of amended claims 1, 14, and 20 accomplish what their preambles set out to complete.

Regarding the association between a characteristic, process, and element, Applicants have amended claims 1 and 14 (and dependent claims 2, 6, and 18) to specifically recite the characteristic as an actor. Applicants respectfully submit that amended independent claims 1 and 14 clearly recite that the actor(s), process(es), and element(s) are associated with each other and

are displayed as associated in a single display. In other words, these three components are associated and their association is displayed. Although the Examiner stated that the drawings fail to show these three associated components, Applicants respectfully disagree. One example of such a display is shown in Figure 1E and described at paragraph [0084]. In this process-span matrix 110 of Figure 1E, processes 114 are associated with elements of span 112, and their associations are represented by intersections (*e.g.*, intersections 116 and 126) in the matrix. Characteristics are associated with the processes and elements by populating the intersections. As described at, for example, paragraphs [0084] and [0099] of the present application, a characteristic could be an actor.

Figure 24 provides another example of a display illustrating the association between a characteristic, process, and element. As described, for example, at paragraph [00185] of the present application, the process-span matrix 2400 associates processes 2402 with elements of a span 2404, and associates characteristics with the associated processes and elements as represented at intersections of the matrix. The characteristic shown in Figure 24 is the number of elements needed for each process. However, as shown and described, the associated characteristic displayed in the matrix can also be, for example, actors, thereby conveying the scope of the outsourcing. The actors would be displayed by clicking on the “scope” tab in the graphical user interface tool. Thus, at least Figures 1E and 24 clearly show the association of a process, element, and actor.

Regarding concrete results, Applicants respectfully submit that each of the independent claims 1, 14, and 20 results in an undoubtedly tangible product embodied in a display, which

could be on paper, on a computer graphical user interface, or any other means of display. For amended claims 1 and 14, exemplary embodiments of the display are shown in Figures 1E and 1F, which map processes of a value chain against elements subject to the processes, and illustrate associated characteristics (*e.g.*, actors) at the intersections of the processes and elements, such that the entire matrix illustrates the scope for the outsourcing. Amended claim 20 recites two displays. The first, which displays actors for associated processes and elements, is shown, for example, in Figures 1E and 1F. The second display, which shows interaction models, is shown, for example, in Figures 16, 17, and 21 and described at, for example, paragraph [00170] of the application. Thus, as embodied in the various displays, independent claims 1, 14, and 20 all provide concrete, tangible results. Indeed, from this useful, concrete, and tangible result, a user of the method of the present invention can better understand an outsourcing transaction and thereby develop appropriate sourcing strategies (*see, e.g.*, paragraph [0030] of the application).

In addition to the § 112 rejections of the independent claims, the Examiner specifically rejected dependent claim 13 under 35 U.S.C. § 112, ¶ 1, for its recitation of the processes of “relate, develop, contact, fulfill, operate, advise, and manage,” the scope of which the Examiner found vague and indefinite. Applicants respectfully submit, however, that these processes describe an exemplary value chain, as is described at, for example, paragraphs [0079] and [0095] and shown in Figure 1F. As disclosed, these processes are designed to stratify any organization into successively lower levels of detail. Examples of the successive levels of detail are shown in Figure 1A and described at paragraph [0079]. Applicants therefore respectfully submit that these processes are adequately supported by the written description.

The Examiner also rejected claims 8 and 16 under § 112, ¶ 2, as unclear with respect to the limitations “organization” and “outsourcer.” Applicants respectfully submit, however, that this rejection is based on a misunderstanding of the term “outsourcer.” As defined in the present application at, for example, paragraphs [0004-5], an outsourcer is defined as the entity to which an operation is outsourced. The organization that is outsourcing the operation is a client or customer of the outsourcer and cannot be an outsourcer. The term “actor” of claims 7, 8, and 16 refers to an entity responsible for furnishing the associated process and element. As an example, an organization could outsource some of the associated processes and elements to the outsourcer, and retain responsibility for other associated processes and elements. In the matrix, the outsourcer would be listed at the intersection of the associated processes and elements for which the organization wished to outsource the responsibility. For the remaining intersections, the organization itself would be listed as retaining responsibility for the associated process and element (not outsourcing to itself, as the Examiner seems to suggest). In this manner, the display illustrates the scope of the outsourcing, with certain associated processes and elements outsourced to the outsourcer and others retained by the organization. Support for these recitations can be found in the specification at, for example, paragraphs [0035], [0040], [0044], [0084], [00104-106], [00153], [00187], and [00190]. Applicants therefore respectfully submit that claims 8 and 16 are not vague or indefinite, and comply with § 112, ¶ 2.

35 U.S.C. § 101

The Examiner rejected claims 1-22 under 35 U.S.C. § 101 for lacking any substantial use of technology (*i.e.*, for not being within the technological arts) and for failing to produce a

concrete result. Because the Board of Patent Appeals and Interferences, in *Ex parte Lundgren* (2004 WL 3561262), expressly rejected any “technological arts” test to determine patent eligible subject matter under § 101, Applicants respectfully request that the Examiner withdraw the technological arts rejection. Furthermore, since there is no requirement for a substantial use of technology in a claimed invention, Applicants have amended claims 1, 14, and 20 to remove references to the use of a computer.

Regarding the Examiner's rejection based on a failure of concrete results, Applicants respectfully traverse the rejection as set forth above in reference to the § 112 rejections.

35 U.S.C. §§ 102 and 103(a)

The Examiner rejected claims 1-22 as anticipated and unpatentable over Barton. Barton, however, fails to teach or suggest at least one feature of each of the independent claims 1, 14, and 20. For example, regarding amended claims 1 and 14, Barton fails to teach or suggest the display of an association between a process, element, and actor on a single display, which conveys the scope of an outsourcing transaction. Indeed, quite unrelated to outsourcing transactions, Barton is focused on identifying and mitigating business risks. As such, Barton associates processes with risks, but does not provide a display of scope as represented by a single display of the association between a process, element, and actor. In addition, regarding claim 20, Barton fails to teach or suggest the display of interaction models between actors participating in an outsourcing.

Barton is directed to methods and systems for assessing compliance programs, including identifying and prioritizing potential risks. (*See, e.g.*, Abstract.) An object of Barton is to

proactively monitor and measure compliance with company policies. (§ [0007].) The policies, or “process” elements, that are assessed include leadership commitment, training, resources, discipline, and enforcement. (§ [0039].) Barton gathers the risk data associated with these process elements by interviewing and questioning the person responsible (*i.e.*, “process owner”) for each of the processes. (§ [0057].)

To identify a process owner for each process element (and its corresponding questions), the process elements are mapped against the process owners, with notations (*e.g.*, “x”) indicating which process owner is responsible for which process element, as shown in the owner’s matrix 100 of Figure 4 of Barton. Notably, this matrix 100 provides only a simple one-to-one correlation between process element and process owner, and associates nothing else with the associated owner and process element. In essence, matrix 100 is merely a tool for identifying the individuals (process owners) from which to obtain the risk data.

After gathering risk data, the data is summarized in a risk QFD matrix 190. (Figure 13; § [0077].) This matrix 190 associates processes (*e.g.*, marketing and product development), categories of compliance risk (*e.g.*, Spirit & Letter and Contractual), and risk scores. Matrix 190 is therefore a tool for summarizing and prioritizing the risks for a business. Notably, however, because Barton focuses on the risk to the business, matrix 190 not only fails to teach or suggest an association between process, element, and actor, but also provides no insight whatsoever into the actors performing the processes.

In stark contrast to Barton, the present invention displays on a single display associations between processes of a value chain, elements subject to the processes, and actors responsible for

furnishing the elements. This displayed association enables an organization to easily understand the scope of an outsourcing transaction, in terms of which actor (*e.g.*, the outsourcer or the organization itself) is furnishing which element. One example of a displayed association is the process-span matrix 110 shown in Figure 1E. This matrix 110 can display the association between processes 114, elements of span 112, and actors at the intersections (*e.g.*, intersection 116), as described at, for example, paragraphs [0084] and [0099] of the present application. Figure 24 provides another example of a display illustrating the association between actors, processes, and elements. As described, for example, at paragraph [00185] of the present application, the process-span matrix 2400 associates processes 2402 with elements of a span 2404, and associates characteristics with the associated processes and elements as represented at intersections of the matrix. As the specification describes, by clicking on the “scope” tab in the graphical user interface, actors would be displayed as the associated characteristic displayed in the matrix. Barton fails to teach or suggest such displayed associations.

In addition to displaying associations between processes, elements, and actors, the invention recited in claim 20 also displays interaction models that illustrate interactions between an organization and an outsourcer that are participating in an outsourcing. Exemplary interaction models are shown, for example, in Figures 16, 17, and 21 and described at, for example, paragraph [00170] of the application. Because Barton fails to teach or suggest the association of actors to processes and elements, Barton necessarily fails to teach or suggest the display of interaction models between actors. The Office Action (at pp. 27-28) fails to address these interaction model limitations of claim 20. In addition, the Office Action cited Figures 4, 12, and

13 in reference to the particular swim-lane interaction models of claim 22, yet these figures do not show in any way interactions between an organization and an outsourcer participating in an outsourcing transaction.

Applicants therefore respectfully submit that independent claims 1, 14, and 20 are patentable over Barton. Applicants also respectfully submit that dependent claims 1-9, 12, 13, 15-19, 21, and 22 are also patentable due at least to their dependence on an allowable base claim.

37 C.F.R. § 1.105 - Requirement for Information

The Examiner has required: (1) clarification of the first offer or disclosure of the service described in the web site (www.sourcinginterests.org) identified by the Examiner; (2) clarification regarding inventorship in light of the inventors listed on this application and the authors of an August 28, 2003 publication at www.sourcinginterests.org; and (3) “details regarding any prior art products or services developed or known of by Applicants or assignee.”

Regarding the service described in the web site identified by the Examiner, the service was developed in the context of a client engagement that began on or about July 2002, and was completed in early 2003. During the course of this client engagement, there were non-public meetings with the client at which elements of the service were described. On May 7, 2003, the day that the provisional patent application (U.S. Provisional Patent Application No. 60/468,256) to which the present application claims priority was filed, Applicants presented aspects of the service to the Sourcing Interests Group using the PowerPoint presentation captioned “Deconstruction and Reconstruction,” which is Exhibit 1 to the provisional patent application.

Regarding inventorship, Applicants confirm that the inventors listed on the present application are correct. Mr. Trevor W. Nagel assisted in presenting the invention to potential clients, in conjunction with the August 28th publication, but did not contribute to the conception of the invention.

Regarding the Examiner's requirement for "details regarding any products or services developed or known of by Applicant's or assignee," Applicants request clarification as to the scope of the Examiner's requirement. As noted by the Examiner, the assignee of the present invention is indeed a major player in the outsourcing and consulting industry. As such, assignee has extensive knowledge of products and services – most of which is irrelevant to the patentability of the claimed invention. Indeed, to Applicants' knowledge, there are no prior art examples of the claimed invention. Applicants understand the Examiner's requirement as a request for information regarding the state of the art at the time the invention was made. Thus, in response to the requirement for details regarding prior art products or services developed or known by Applicants or assignee, Applicants again note that the specific service that is the subject of the present invention was developed in the context of a client engagement that began around July 2002. To provide information regarding the state of the outsourcing and consulting industry in the 2002-2003 time frame, Applicants are submitting herewith an Information Disclosure Statement that includes outsourcing references from that time frame. Specifically, Applicants are submitting: (1) the book, Technology Outsourcing: A Practitioner's Guide (John Angel ed., The [UK] Law Society 2003), which purports to describe the state of outsourcing at the time of its publication; (2) the book, Strategic Outsourcing: Risk Management, Methods and

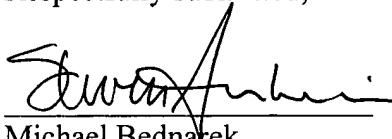
Benefits (American Management Association 1998); (3) the article "Structuring Outsourcing Transactions" (2003) by Trevor W. Nagel; and (4) examples of a "responsibility matrix," which is a tool used to document a scope of work (responsibility). Applicants also direct the Examiner's attention to the following books for which copies cannot be readily obtained: (1) Information Systems Outsourcing: Myths, Metaphors and Realities (John Wiley Series in Information Systems) (John Wiley & Sons 1993); and (2) Information Technology Outsourcing Transactions: Process Strategies and Contracts (John Wiley & Sons 1996), by John K. Halvey and Barbara Melby. These submissions do not represent that any referenced document is material or constitutes "prior art."

In view of the foregoing, all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone Applicants' undersigned representative at the number listed below.

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